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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,847	12/09/1999	TOAN TRINH	7114	8139

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EXAMINER	
MOORE, MARGARET G	
ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/457,847	TRINH ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14, 15, 33 to 42, 45, 46, 48 to 50, 56 and 60 to 64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14, 15, 33 to 42, 45, 46, 48 to 50, 56 and 60 to 64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 14, 15, 33 to 42, 45, 46, 48 to 50, 56 and 60 to 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner would like to apologize for not making this rejection in the last office action. The list monomer selection in (A) is incomplete. See for instance claim 56 as found in the claims submitted 3/26/03. When presenting the amended claims in the response dated 3/30/04, lines were omitted. These lines are omitted in the current claims as well and the Examiner notes that, as presently worded, the monomers are very confusing and improper. For instance, reference to "said acids" lacks antecedent basis and it is unclear how low molecular alcohols are incorporated into the polymer. This appears to have been an unintentional oversight, but must be corrected before the claims could pass to issue.

2. Claims 14, 15, 33 to 42, 45, 46, 48 to 50, 56 and 60 to 64 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions having a pH range of from about 9 to about 10.5 when the compositions contain a shape retention polymer having hydrophilic monomers with an acid functional pending group, does not reasonably provide enablement for a composition having this pH range having any of the monomers listed for (A). The specification clearly indicates that monomers with an acid functional pending group are required for this pH range. See page 26, lines12 to 20. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

3. For reasons consistent with that noted by applicants, the instant claims as amended are neither taught nor suggested by the prior art. That is, the teachings in Vogel et al. fail to teach or suggest a particular pH range and there is no motivation provided by the prior art that would render such a range obvious. However, in view of this newly added limitation, the following new grounds for rejection is made.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 14, 15, 33 to 42, 45, 46, 48 to 50, 56 and 60 to 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Trinh et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The Examiner notes that this application already contains a terminal disclaimer over Trinh et al. Applicants have stated that Trinh et al. and the instant application were commonly owned by or subject to an obligation of assignment to the same assignee. As such Trinh et al. cannot function as prior art under 35 USC 103. However, it remains prior art for anticipatory purposes under 102(e).

Trinh et al. teach a composition for odor and wrinkle control. Starting on column 30 through column 34 Trinh et al. teach the required component (A) in the claimed amount. This meets the limitations of claims 14 and 15. The top of column 35 teaches the claimed pH range while column 40 Trinh et al. teach the article of manufacture, specifically a spray dispenser. This anticipates each of claims 14, 15, 45, 46, 48, and 56. Note for instance the tables on column 51, which show a composition meeting

claims 33 to 38 and 42. The bottom of column 36 teaches the limitation of claims 39 to 41.

Regarding claims 49, 50 and 60 to 62 the Examiner notes that the article of manufacture specifically discussed in Trinh et al. does not explicitly contain a set of instructions. The Examiner notes, however, that the article of manufacture in Trinh et al. is prepared for the same purpose of the claimed article of manufacture. That is, both articles of manufacture are prepared and intended for use to control wrinkles as well as control microorganisms (see column 13, line 27 and column 38, line 38). Thus any article of manufacture prepared from the composition of Trinh et al. is inherently going to contain a set of instructions. That is, any spray bottle of the odor and wrinkle controlling composition of Trinh et al. will necessarily contain a set of instructions. In this manner, while not explicitly taught by Trinh et al., these claims are inherently met by Trinh et al.

6. Claims 14, 15, 33 to 38, 42, 45, 56 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Jellinek.

Jellinek teaches a composition for the treatment of textile materials. This contains a film forming polymer prepared from the same monomers as found in component (A), as well as claims 14 and 15, and meeting the required Tg limitation. See the top full paragraph on column 6 and the monomers used to prepare the film forming polymer in Example 5. The top of column 10 teaches a pH range that has a clearly delineated upper limit within the claimed range. Example 5, part G (on column 20) prepares a composition having a pH of 9, a film forming polymer meeting (A) in appropriate amounts. The top of column 12 teaches that the composition can be stored for periods of time; column 9, lines 45 to 50, teaches that the composition can be applied by means of spraying, brushing, padding, dipping and the like. While not specifically mentioned, the composition of Jellinek must be packaged in a container. For the composition to be stored, it must be in a container. For the composition to be sprayed, it must be in a spray container. Clearly, to transport the composition of Jellinek to the consumer the composition must be in a container. In this manner Jellinek anticipates instant claim 56,

as well as claims 14 and 15. With regards to claims 33 to 38, see column 7, which meets these requirements. Jellinek is silent as to the presence of an short chain polyhydric alcohol, meeting claim 42. In order to spray the composition of Jellinek, it must be in a spray dispenser, meeting the requirements of claim 45.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jellinek.

Patentee fails to specifically teach these spray dispenser types, but one having ordinary skill in the art would have readily recognized these as conventional spraying means. Thus one having ordinary skill in the art, upon realizing that the composition of Jellinek et al. could be sprayed, would have been motivated to include the composition in such a container to obtain the end result. As such these claims would have been obvious.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/10/04